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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,935	03/23/1999	KATHLEEN L. COVERT	EN997064	9143

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EXAMINER

MARKOFF, ALEXANDER

ART UNIT	PAPER NUMBER
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1746

12

DATE MAILED: 03/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/274,935

Applicant(s)

COVERT ET AL.

Examiner

Alexander Markoff

Art Unit

1746

--Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED 14 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Alexander Markoff
Primary Examiner
Art Unit: 1746

Continuation of 5. does NOT place the application in condition for allowance because:

The Applicants state that the claims are rejected over Ferrier et al in view of Dutkewych et al.

The Applicants traversed the rejection.

The Applicants argue that they could not exclude the use of nitric acid from the claims because it would amount to a negative limitation in the claim, which, according to the applicants, is against PTO rules.

The Applicants further argue that the claims should be interpreted in view of the specification, and that the specification state that nitric acid should not be used.

This is not persuasive because of the following:

First, the PTO rules do not exclude the use of negative limitations if they are supported by the specification and would not introduce a new matter.

Second, exclusion of the use of the specific compound from the claims could be done not only by the use of negative limitations but by other ways, for example, by the recitation of the compounds which should be used and the use of the language "consisting of".

Third, the applicants arguments contradict to their own specification, which states that nitric acid can be used for the process of the invention. See at least page 13, lines 9-11.

Fourth, the examiner was not able to find in the specification a support for the applicants statement "Applicants' specification clearly states that nitric acid would remove too much copper, and should not be used". In contrast the specification states that nitric acid could be used. See again page 13, lines 9-11.

Fifth, the applicants state that "the invention was rejected over FERRIER et al in view of DUTKEWYCH et al." It is respectfully noted that there is no such rejection pending. The claims are rejected over JP 5-148,658 alone and in combination with other references. The rejection over Ferrier et al in view of Dutkewych et al was presented earlier, in the first Office action mailed in 2000. However, two last Office actions mailed in June and December of 2001 do not comprise such rejection. The applicants are respectfully requested to respond to the most recent Office action and argue the pending rejections.

Alexander Markoff
3/27/02

ALEXANDER MARKOFF
PRIMARY EXAMINER